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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,077	09/17/2003	Tsuneaki Kawanishi	H64-154708M/MNN	5060
21254	7590	05/04/2005	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			RODEE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,077

Applicant(s)

KAWANISHI ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/5/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to a developer, classified in class 430, subclass 108.8.
- II. Claims 4-7, drawn to an apparatus, classified in class 399, subclass 252.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as in an imaging process where the developer contacts a dielectric imaging sheet having an ionographic image formed thereon and the toner of the developer remains on the dielectric sheet and is fixed to the sheet without transfer. See MPEP § 806.05(d).

Applicants are advised that the developer in the instant apparatus claims of Group II represent a material worked upon by the apparatus because it is consumed during the desired and intended operation of the apparatus. As such, the developer is not a material limitation on the apparatus. See MPEP 2115. Further, the developer does not provide any structure to the apparatus. Each of the structural components of the apparatus remains the same whether the developer is present in the apparatus's developing unit or not. See *Ex parte Masham*, 2 USPQ2d 1647 and MPEP 2114. Consequently, the developer is not a patentable limitation to the apparatus.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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A telephone call was made to Sean McGinn on 15 April 2005 to request an oral election to the above restriction requirement, but did not result in an election being made. However, applicant subsequently provided a written response electing Group II with traverse in the reply filed on 22 April 2005. The traversal is on the ground(s) that inventions have substantially coextensive searches that do not require any additional burden on the Examiner. This is not found persuasive because the search for apparatus does not require a search of the toner because the toner is a material worked upon by the apparatus and is not a patentable limitation to the apparatus. The possible additional financial requirements discussed by applicants are noted but this is not a persuasive grounds of traversal because this position does not address the separate patentability issue.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

a) It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

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- b) It does not identify the citizenship of each inventor.
- c) It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

Claim Objections

Claims 6 and 7 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims fail to further limit the parent claim because they are directed to the toner, which as discussed above, does not impart a patentable limitation to the apparatus. See MPEP 2115 and *Ex parte Masham, supra*. The apparatus in these dependent claims has the same scope of protection as in the independent claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by *Organic Photoreceptors for Imaging Systems* to Borsenberger *et al.*, pp. 6-17.

Borsenberger discloses the conventional imaging apparatus in Figure 5 having a photoreceptor drum, a corona charging apparatus 1, an exposure device for forming an electrostatic latent image 2, a development unit for supplying developer to the latent image 3 to

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form a toner image, a transfer unit for transferring the toner image to paper **4**, and a fixing unit for fixing the toner to the paper **5**. As discussed on page 11, the developer is a two-component developer having carrier and toner. On pages 15 and 16 Borsenberger teaches that the hot roll pressure devices are commonly used to fix the toner image to the receiver. This is a heat contact system. Also, see Figure 4, item 5 and Figure 7.

Applicants are advised that the developer in the instant apparatus claims represent a material worked upon by the apparatus because it is consumed during the desired and intended operation of the apparatus. As such, the developer is not a material limitation on the apparatus. See MPEP 2115. Further, the developer does not provide any structure to the apparatus. Each of the structural components of the apparatus remains the same whether the developer is present in the apparatus's developing unit or not. See *Ex parte Masham*, 2 USPQ2d 1647 and MPEP 2114. Consequently, the developer is not a patentable limitation to the apparatus.

Claims 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawanishi *et al.* in US Patent Application Publication 2002/0022189.

Kawanishi discloses an imaging apparatus as shown in Figure 1. As discussed starting in ¶ [0133], an electric charger **5** is disposed opposite to the surface of the photosensitive drum **4** to uniformly charges the surface of the photosensitive drum **4** which passes to be opposite to the electric charger **5**. A laser beam **6** for exposing the surface of the photosensitive drum **4** charged uniformly is used to form an electrostatic latent image on the surface of the photosensitive drum **4** in response to a print information signal supplied from an information processing apparatus. A development unit **7** is disposed opposite to the surface of the photosensitive drum **4** on which the electrostatic latent image has been formed. The development unit **7** has a development function for forming a toner image by causing the

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foregoing toner to adhere to the surface of the photosensitive drum **4** by an electrostatic force of the electrostatic latent image.

A paper sheet **9** fed from the paper feeding roller mechanism **10** is brought into contact with the surface of the photosensitive drum **4** such that the toner image can be transferred to the surface of the paper sheet **9**. The transfer unit **11** imparts a charge, the polarity of which is opposite to that of the toner image, to the rear surface of the paper sheet **9**, which has been brought into contact with the surface of the photosensitive drum **4**. Thus, an electrostatic force is generated which transfers the toner image formed on the surface of the photosensitive drum **4** to the paper sheet **9**. A conveying belt **12** constituting a portion of a paper conveying means conveys the paper sheet **9**, on which the toner image has been formed, to a contact type heating fixing unit **13** to be fixing means (also see ¶ [0118]). A fixing roller **14** forming a pair composed of a heated roller **14a** and a backup roller **14b** positioned in hermetic contact with each other heats and pressurizes the paper sheet **9** to fix the toner image on the surface of the paper sheet **9**.

Incidentally, the toner used in the apparatus contains a styrene-acrylate binder resin, a metal complex charge control agent (e.g., Bontron S-34), a carbon black colorant, and a polyethylene wax having a crystallinity of less than 90 %. Example 1 produces a specific toner according to the invention with a wax having a crystallinity of 85 % and a DSC peak at 87 °C (¶ 0080). The toner is mixed with a silicone resin coated magnetite carrier (¶ 0117) to form the developer of the invention. Note the similarity of the toner and developer to that used in the instant specification.

Applicants are advised that the developer in the instant apparatus claims represent a material worked upon by the apparatus because it is consumed during the desired and intended operation of the apparatus. As such, the developer is not a material limitation on the apparatus.

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See MPEP 2115. Further, the developer does not provide any structure to the apparatus. Each of the structural components of the apparatus remains the same whether the developer is present in the apparatus's developing unit or not. See *Ex parte Masham*, 2 USPQ2d 1647 and MPEP 2114. Consequently, the developer is not a patentable limitation to the apparatus.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdr
26 April 2005


CHRISTOPHER RODEE
PRIMARY EXAMINER